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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,322	09/05/2006	Hermann Uhr	CH-8402/LeA 36,709	4562

7590 04/29/2009
Lanxess Corporation
Patent Department
111 Ridge Park West Drive
Pittsburgh, PA 15275-1112

EXAMINER

PUTTLITZ, KARL J

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/554,322	Applicant(s) UHR ET AL.	
	Examiner KARL J. PUTTLITZ	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/16/2009 has been entered.

Election/Restrictions

Claims 15 and 17-20 are withdrawn from consideration since these compounds are patentably distinct from the elected compounds, i.e., different stereochemistry.

The prior art rejection has been maintained and repeated below. Applicant's remarks in connection with this ground of rejection are also addressed.

The following is a new ground of rejection:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

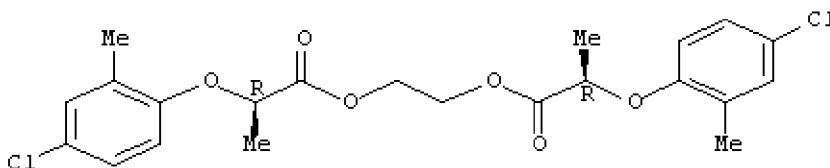
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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 5-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Mathiassen et al., Weed Research (1998), 38(4), 283-289 (Mathiassen).

Mathiassen teaches the following compound as an herbicide:



See attached CAS online citation 130:1296 [retrieved 27 April 2009] from STN; Columbus, OH, USA.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 9506408, as evidenced by counterpart U.S. Patent No. 5,672,568 to Huer et al. (Huer) or Mathiassen (above) in view of Aberg, Swedish J. agric. Res. 1973, 3, 49 (Aberg).

WO 408 describes the use of specific esters of 2-(4-chloro-2-methylphenoxy)propionic acid for the protection of buildings, building materials and insulation compounds against root penetration. Moreover, Aberg teaches that in herbicidal applications in crop protection where 2-(4-chloro-2-methylphenoxy)propionic acid is employed, the R-(+) isomer is markedly more effective than the S-(-) isomer or the racemic mixture. Accordingly, the R-form of the recited compounds is known and the prior art provides sufficient motivation for its isolation and use in protecting buildings from root damage.

With regard to the diester compounds in claim 15, Heuer also contemplates these compounds, see attached CAS online citation 124:145627 [retrieved 27 April 2009] from STN; Columbus; OH, USA.

Applicant argues that the applied references fail to teach or suggest polyethylene glycol esters of (+) MCPP acid, or their use in herbicidal applications. However, the polyethylene glycol ester is known, based on Heuer. In this regard, Aberg teaches that the (+) isomer of MCPP is more effective, therefore, strongly suggesting the (+) isomer of MCPP esters, since Aberg teaches that this isomer of MCPP derivatives, including the polyethylene glycol esters of Heuer, is herbacidally effective.

Applicant also argues that there is no reason to combine the applied references since one reference teaches esters, while the other reference teaches acids. However, this assertion ignores the fact that it is well within the purview of those of ordinary skill to apply the teachings of Aberg to MCCP type compounds, as a whole, including the

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esters, and specifically, the benefits of the R isomer can predictably be applied to esters.

The double patenting rejection also remains outstanding:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-14 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S.

Patent No. 5675032. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The conflicting claims recite the instant reaction (claim 1 of conflicting patent).

The conflicting claims recite the instant compounds (claim 6 of conflicting patent).
see MPEP 804 "the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC 103 rejection". In this regard, the recited esters invariably include the instant R-form.

The conflicting claims recite the instant methods of use (claim 7 of the conflicting patent).

The conflicting claims recite the instant methods of use (claim 8 of the conflicting patent).

Again, there are no reasons set forth why the benefits of the R isomer cannot be applied predictably to esters.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan, can be reached at telephone number (571) 272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Karl J. Puttlitz/

Primary Examiner, Art Unit 1621